REMARKS

The instant amendment is submitted in connection with the filing of a Request for Continued Examination. Support for the amendment to the claims can be found at least in the preamble to the claims as originally filed and at page 14, lines 1-3. No new matter is submitted. Entry of the amendment is respectfully requested.

As a preliminary matter, the undersigned would like to thank Examiner Lamm for the courtesies extended by her during a telephone interview conducted on Sept. 13, 2004. In particular, proposals made by applicants to address the issues raised by the examiner in the final rejection were discussed. The present amendments and comments are in consideration of the examiner's helpful suggestions.

Claims 22, 23, 25-36, 83-91, 93, 94, 96 and 97 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Robinson et al.*, U.S. 6,071,539 (hereinafter "*Robinson*") for the reasons of record in the prior, non-final rejection mailed July 31, 2003. Similarly, Claim 95 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Robinson* in view of *Norling et al.*, U.S. 5,958,458 (hereinafter "Norling"), also for reasons of record in the same Office Action. These rejections are respectfully traversed.

The present invention is clearly directed to dosage forms wherein transfer of the active drug occurs across the oral mucosa:

> "The dosage form may be administered to a human or other mammalian subject by placing the dosage form in the subject's mouth and holding it in the mouth, either adjacent a cheek (for buccal administration), beneath the tongue (for sublingual administration) and between the upper lip and gum (for gingival administration)."

(Application, page 15, lns. 1-6; emphasis added)

This must be contrasted with the disclosure of *Robinson*, wherein the tablet is taken by mouth and the tablet composition is designed to deliver the active ingredient via the stomach or intestines; as stated in the patent:

> "Thus, once the tablet is placed in the patient's mouth, it will disintegrate substantially completely without any voluntary action by the patient. Even if the patient does not chew the tablet, disintegration will proceed. Upon disintegration of the tablet, the therapeutic compound, which itself can be particulate, is released and can be swallowed as a slurry or suspension."

(*Robinson*, col. 8, lns. 11-13)

This is an art recognized distinction:

> Most tablets are intended to be swallowed, the active ingredients being absorbed from the gastrointestinal tract. There are some special types of tablets, however, which are intended for administration in other ways. Most of the tablets discussed in this chapter are intended for adsorption through the mucosal lining of the mouth, either sublingually (*i.e.*, from the area beneath the tongue) or buccally (*i.e.*, from the area between the cheek and gum)[ ]. (emphasis supplied)

James W. Conine, *Special Tablets*, in Pharmaceutical Dosage Forms: Tablets Vol. 1, 329 (Herbert A Lieberman *et al.* eds,. 1989). *See* also (1) *Alternative Routes of Drug Administration-Advantages and Disadvantages (Subject Review)*, American Academy of Pediatrics Committee on Drugs, Pediatrics, Vol. 100, No. 1 July 1997, 143, 147 also discusses the effect on drug

degradation, absorption and side effects based on oral transmucosal versus orogastric drug administration; and (2) *The Alcohol and Other Drug Thesaurus*, National Institute of Health, National Institute on Alcohol Abuse and Alcoholism (Third Edition, 2000, U.S. Dept. of Health and Human Services), accessible at http://etoh.niaaa.nih.gov/AODVol1/aodhnef.htm), classifies and distinguishes oral enteral administration from administration by way of absorption through the oral mucosa. (Copies enclosed with IDS)

Thus it can be seen that the stated recitations in the present claims of "buccal, sublingual and gingival administration," and "administration across the oral mucosa" have a specific meaning in the medical/pharmaceutical art. And the clear teaching of *Robinson* is that it is directed to tablets intended to be swallowed, *i.e.*, the oral enteral or orogastric route, for delivering an active ingredient, something which is art recognized as being distinct.

The examiner will appreciate that there is simply no disclosure, recognition or understanding in *Robinson* of administering an active ingredient across an oral mucosa, of buccal administration, of sublingual administration, or of gingival administration. Nor is there any teaching, suggestion or motivation for adjusting an ingredient or parameter, such as the amount of an effervescent couple and/or pH, in order to improve penetration of an active pharmaceutical agent across the oral mucosa.

It is respectfully submitted that the present invention and its teachings of buccal, sublingual, or gingival administration and of "administration across the oral mucosa" immediately conveys to one skilled in the art that, in the claimed tablet the active drug is delivered to the patient transmucosally and

not orogastrically, as in *Robinson*. And perhaps more to the point, there is nothing in *Robinson* that even alludes to transmucosal administration.

If any transfer across the oral mucosa occurs in *Robinson*, it is a transient, undefined, unintended effect and whether or not any occurs has been proposed by the examiner, not by the reference. Furthermore, it is respectfully suggested that such effects have been proposed by the examiner only in view of applicants' teachings and arguments. Withdrawal of the rejection of Claims 22, 23, 25-36, 83-91, 93, 94, 96 and 97 on this basis is respectfully requested.

The examiner has stated that an active ingredient in *Robinson* will be inherently absorbed in the mouth "at least to some extent." (Final rejection, page 3, lines 12-13, emphasis supplied). There is no objective evidence of record to sustain this point. Moreover, it is contrary to the overall teaching of *Robinson* and it is *Robinson*'s teachings that are relevant. Moreover, "[t]he mere fact that a certain thing *may* result from a given set of circumstances is not sufficient [to establish inherency.]", *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). A retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. *See In re Newell*, 891 F.2d 899, 901 (Fed. Cir. 1989). It will be appreciated that inherency is predicated on the fact that something will necessary and always happen while obviousness assumes that the claimed invention has not been achieved. Understandably, the Patent Office has a difficult time meeting its burden under these circumstances.

Finally, in the final rejection, the examiner took the position that the claim language, namely "adapted for direct oral administration across the oral mucosa" appeared in the

claim preamble and, therefore, was not a limitation and was not given patentable weight. Applicants respectfully submit that the body of the claims required buccal, sublingual or gingival administration which, as noted above, are methods of delivering a drug across the oral mucosa. Thus, the claims and the invention were and are directed to this concept. Even if it were proper to ignore the preamble in this case, a position with which applicants disagree, the claimed invention still patentably distinguished *Robinson*'s sole teaching of swallowing the active ingredient for administration through the digestive tract.

In addition, applicants have amended the independent claims to incorporate the requirement of transfer across the oral mucosa into the body of each independent claim; clearly it must be accorded patentable weight. The proffered amendments are not intended to narrow the claims and, in applicants' opinion, the amendments do not effect a narrowing since the claims were originally directed to this invention and applicants had distinguished the invention over the art on this same basis.

Applicants have also amended the claims to include the phrase "suitable for." This was done to further clarify that, in accordance with the invention, a tablet must be able to transfer the active ingredient across the oral mucosa in a therapeutically meaningful manner. Merely allowing for the possibility of transferring an active ingredient to "some extent," as the examiner argues may occur in *Robinson* is not commensurate with the requirement that the active ingredient be administered across the oral mucosa. In this regard, the examiner's attention is invited to the decision *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 9890, 54 U.S.P.Q.2d 1227 (Fed. Cir. 2000), *cert. denied,* 531 U.S. 1183

(2001). In that case, the patent's 41 claims to gasoline compositions that reduced automobile tailpipe emissions were held not anticipated by prior art specialty fuel compositions, such as racing and aviation fuels. All of the claims began with either the phrase "An unleaded gasoline suitable for combustion in an automotive engine" (emphasis added) or the phrase "An unleaded gasoline fuel suitable for combustion in a spark ignition automotive engine" (emphasis added). The Federal Circuit held that the district court correctly interpreted "suitable for" in the context of the claims as having patentable significance in conjunction with the other compositional features of the claim. Respectfully, the same circumstances apply herein. Since the *Robinson* tablet is directed to administration of a drug by swallowing the disintegrated, dissolved tablet, it is not "suitable for" administration of a medicament across the oral mucosa.

In the office action mailed July 31, 2003, Claim 95 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Robinson* as applied to claim 22 and further in view of *Norling et al.*, U.S. 5,958,458 (hereinafter "*Norling*"). Applicants provided a comprehensive analysis of *Norling*, focusing on the particular portions cited by the examiner as well as the whole of the reference. However, in the Final Rejection mailed May 18, 2004 the examiner addresses that analysis by stating that it was "applicant's argument that there is no suggestion to combine the Robinson and *Norling* references."

Respectfully, applicants' arguments encompassed substantially more, *e.g.*, pointing out the failings of the *Norling* disclosure with regard to the substance of the claimed invention and how the deficiencies of *Robinson* and *Norling* are cumulative, rather than *Norling* curing the deficiencies of

Robinson with regard to claim 95. However, in view of the further amendments to the claims, it is respectfully suggested that claim 95 is patentable over the combination of *Robinson* and *Norling* even if, for the sake of argument only, it is accepted that the references can be combined. Clearly, selectively extracting a passing reference to fentanyl from *Norling* and incorporating it into *Robinson* does not convert *Robinson* into an invention that renders obvious, under accepted standards applied to 35 U.S.C. §103(a), an invention directed to a tablet suitable for oral transmucosal delivery of a drug. The deficiencies of *Robinson* addressed in detail above are not cured by the subject matter of *Norling* adopted by the examiner. Withdrawal of this aspect of the rejection is respectfully requested.

In applicants' prior response, it was acknowledged that Claim 95 is provisionally rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over claims 2-4 of co-pending Application No 10/080,016. Again, applicants understand the examiner's position with regard to the obviousness-type double-patenting rejection of claim 95. Appropriate action (*e.g.*, a timely-filed terminal disclaimer in compliance with 37 CFR § 1.321(c)) will be taken as required to overcome this rejection at such time as the examiner indicates that there is allowable subject matter, but for the obvious-type double-patenting rejection.

As it is believed that all of the rejections set forth in the official action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the examiner does not believe that such action can be taken at this time, it is respectfully requested that she telephone applicants' attorney at

(908) 654-5000 in order to overcome any additional objections which she might have.

If there are any additional charges in connection with this requested amendment, the examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: October 26, 2004

Respectfully submitted,

By _____
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